

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

REMARKS CONCERNING THE AMENDMENTS

The above amendments have been made in an effort to more clearly define the present invention. Antecedent basis for the added limitation regarding functions provided by components in the claims such as the I/O interface may be found generally in the specification and, for example, on page 9, lines 10-27. It is pointed out in this section and others that the I/O interface may comprise logic and that the logic may perform functions such as converting signals, buffering, and latching. There is literal antecedent basis for the new claim language in the original specification.

STATUS OF THE REJECTIONS

The above amendments to the claims emphasize distinct points of novelty and unobviousness over the art of record. Those specific points, in addition to those presented in the arguments filed in the response after Final Rejection and repeated below, include at least that:

The references of record do not enable communication from a general computerized gaming processor. In each case, the processor is specific to the apparatus, with formatting specific to the peripherals. There is no signal conversion functionality shown in the references.

The references of record, in retrofitting arcade games, rip out all pinning and connection elements from the original apparatus. Claims 9-17 and 21 emphasize this point by requiring that the connector in the original apparatus (e.g., pinning, cables to individual user interface devices) is not removed, yet there is communication enabled from the universal gaming controller and the old user interface devices.

Claims 27-37 also require that the I/O interface has digital logic to perform at least one function selected from the group consisting of encoding various signals, converting signals from one voltage level to another, inverting signals, multiplexing signals, decoding signals, buffering, latching signals and converting signals between protocols.

Each of these specific limitations is not shown by the references used in the Final Rejection.

Response filed to Final Rejection, with additions regarding the above amendments.

Rejections Under 35 U.S.C. 103(a)

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.
Serial No.: 09/405,921
Filed September 24, 1999
Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

Docket No.: PA0368.ap.US
Examiner: S. Ashburn
Group Art Unit: 3713
UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

I. Claims 1-8, 11-28 and 31-33 have been finally rejected under 35 USC 103(a) as unpatentable over McCauley (U.S. Patent No. 6,263,392) in view of Kelly (U.S. Patent No. 6,015,344).

II. Claims 9-11, 13-16 and 29 are rejected under 35 USC 103(a) as unpatentable over *Arcade Machine Retrofit* (October 1996) in view of Kelly.

III. Claim 12 is rejected under 35 USC 103(a) as unpatentable over *Arcade* in view of Kelly (as in rejection II) when further considered with *McCauley*.

Background Discussion of the Art and Field of the Invention

It is extremely important to understand the background of technology in the field of gaming that existed at the time that the present invention was conceived and reduced to practice. When new games had been developed within the gaming industry, it had been necessary to develop a customized peripheral interface to support the game (Page 6, lines 25-27). The prior art commercial status of gaming development at the time that the present invention was made relied upon development of complete systems (with certain components such as coin/currency components, video monitors, etc. being fairly constant within individual manufacturers, but not within the industry). The cabinets and controllers were not universal, and continue to be diverse, even within a single manufacturer's line of products. Given the physical minimums of housing, lighting and sometime coin/currency control, individually designed hardware and software (motherboards, sisterboards, slave boards, input/output connection, pinning connections, game rules, image data, peripheral controls, security controls, authentication controls, etc.) had to be individually developed for each gaming format and type of gaming unit. This business system and structural format almost literally required "reinventing the wheel" each time that a new gaming format was desired to be introduced. This business system and structural format significantly slowed the introduction of new gaming formats and contributed to the underperformance of gaming equipment and the obsolescence of gaming apparatus when the shelf life of a gaming format declined. For example, when a gaming format with a title and image that was once topical has aged and play had diminished, the gaming apparatus (costing from \$8,000 to \$20,000 per unit) could only be warehoused or sold to a lower tier casino, where

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

it would again be eventually warehoused. This system and the unique structure provided on each gaming format created substantial wastage in the industry, both in money, material and space.

The system of the present invention, including the universal game controller of the present invention, is based on a standard PC-type unit. The replacement of the inventive unit, that has novel structural features in the hardware and software, provides all game functions necessary to implement a wide variety of games by loading various program code on the universal controller and then separately providing unique game information (e.g., from a separate gaming application-specific kernel) (see page 8, line 19 through page 9, line 4 of the specification). What is intended to be included in the term "game functions" includes button controls, coin acceptors, touch screen coordinates, credit managers, currency acceptors, operating system, security devices, game operating code and the like (Page 11, lines 14-22; page 15, line 23 through page 16, line 7). Additional game functions could be a store of images (e.g., cards or roulette wheel/symbols; see page 20, lines 1-4). These are separately provided with the I/O system as pinning-hardware/software in the PC-type system with a motherboard (Page 12, line 18, through page 19, line 8). The harness is fitted to the unique structure of the gaming device and the motherboard is connected to or integral with the harness/pin system (page 13, lines 5-8).

This type of system is quite distinct from conventional implementation of casino gaming systems where the entire system and program is originally installed with both game peripherals and game rules controlled on the same board, so that replacement of a game in a given machine requires the complete replacement of both the game board and the peripheral controls. The game rules (as embodied in the software) also must be uniquely and completely reconstructed and replaced. In the system claimed in the enabled practice of the invention, the invention provides a distinct set of a) pinning connections and game peripherals and b) game rules/controls. Once these distinct sets are provided, the old game rules from the original video gaming system may be executed through the new pinning/peripheral system and software or a new set of games rules using the inventively provided pinning system/game peripherals previously installed. In this manner, game designers may need to develop only the rules of the game, and the system peripherals are already available in the apparatus. Additionally, even rules common to the games of poker may be retained, as with relative ranks of hands, the use of 52 cards, poker rankings for

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

a 5 card game, card faces, etc., and other rules are imputed by the game designer, such as how many cards are drawn and discarded. This dramatically reduces game development time. (e.g., page 15, lines 2-7)

The provision of an I/O interface having digital logic to perform at least one function selected from the group consisting of buffering, latching signals and converting signals between protocols enables the computer to universally work with a variety of systems/apparatus/formats, as the ability to convert the signal does not require repining or reconnecting all user interface devices. For example, where pinning connections are provided, the computer links through the I/O with conversion (e.g., format conversion) functionality and the original pinning and the original user interfaces may be retained. This is in clear distinction to *Arcade* where all the wiring is ripped out. This feature also relates to the amendments to the claims whereat least some of the original connections to user interface devices were not removed.

RESPONSE TO THE REJECTIONS

The Rejection of Claims 1-8, 11-28 and 31-33 Under 35 U.S.C. 103(a)

Claims 1-8, 11-28 and 31-33 have been finally rejected under 35 USC 103(a) as unpatentable over McCauley (U.S. Patent No. 6,263,392) in view of Kelly (U.S. Patent No. 6,015,344).

The rejection is believed to be fairly characterized as asserting that McCauley shows:

- a) Controlling a wagering or video game with a generic computer (col. 1:14-57)
- b) Employing an IBM compatible personal computer as a controller (Col. 6:47-54)
- c) Coupling a communication port to the controller (Col. 6:47-54)
- d) Employing an interface assembly comprising one or more user interface devices (Col. 6:47-54)
- e) Providing user interface devices including buttons and joysticks (Col. 6:23-34)
- f) Configuring an input/output (I/O) interface to communicatively couple the interface assembly to the communication port (Col. 55-60 and 9:34-41)

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

- g) Employing a generic game controller comprising a pin connector, circuit board connector, circuit board with controls for peripheral devices, and port connector connecting peripherals. (Col. 7:8-27)
- h) Communicating via standard POC communication ports including serial, parallel, and universal serial bus (Col. 6:47-49)
- i) Providing a credit management unit as a user interface device (Col. 23-34)
- j) Selecting credit management devices from a group including coin acceptors, coin recognition systems, currency acceptors, currency recognition systems, credit card readers, and smart card readers. (Col. 23-24) and
- k) Providing a security device as a user interface device (Col 4:15-35).

The Office Action then proceeds to list on Page 4 of the Office Action mailed on 14 June 2002, five specific features that are believed to not be described by McCauley. Those features are listed as:

- “a) Controlling a wagering game. (*Claims 1, 10, 18, 19, 22*)
- b) A random number generator to determine random outcomes. (*Claims 27, 28, 31-33*)
- c) A pay table identifying payouts based on the occurrence of random events. (*Claims 31-33*)
- d) Peripheral devices including pull-arms, touch screen displays, tilt switches, device integrity switches, game operating code and images. (*Claims 4, 8, 13, 17, 23*)
- e) An embedded mother board employed as a controller (*Claims 20, 21*)

It is then asserted that, “(R)e此ardless of the deficiencies, the features were known in the art at the time of the invention and would have been obvious to an artisan of ordinary skill in view of *Kelly*.”

The rejection asserts the relevance of *Kelly* to the disclosure of McCauley by the acknowledged recitation of both games and wagering gaming systems disclosed by *Kelly*. It is then asserted that *Kelly* shows each of the elements described in McCauley and that it would be obvious to one of ordinary skill in the art to combine the disclosed elements of *Kelly* into the disclosed system of McCauley.

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

It is first to be noted that the McCauley and Kelly art cited against the present invention is not combined in any fashion motivated by the teachings of the references. The two references have been combed to find disclosure that is asserted to provide knowledge of the existence of hardware and software elements that individually **could be used by each of the** references (the elements are primarily incidental disclosures in the references, not essential elements of the respective inventions). These diverse and random individual teachings are then virtually combined to assert that an article could have been made by selecting each of these elements from the various references.

The difficulty or even inability of combining these references in a manner that would be motivated by the teachings of the references themselves is very large. Even looking at what the references teach one skilled in the art, the references start in the wrong technical region and move in a direction that moves them no closer to the practice of the present invention.

McCauley, for example, teaches:

A method and an apparatus to interface multiple peripheral devices to a host computer is provided. An interface control module located in a multi-user computer game arcade system interfaces a host computer via a Universal Serial Bus (USB) to one or more joysticks, steering wheels, trackballs, coin op/bill counters, credit card readers and/or optical guns. A set of connectors allows the game builder or player to interface a variety of input peripherals to the interface control module. The interface control module recognizes the HID type of the input peripheral by the type of the selected connector, and then provides HD reports that describe each input device to the HID compliant software system of the host computer. The interface control module may support 127 HID peripherals. A watchdog function of the interface control module detects host computer malfunctions and crashes, and boots the host computer while retaining coin credit input data received proximate to and during the malfunction and recovery.

The system is directed not towards a stand alone gaming system with all essential hardware and software included therein for enabling play of a wagering game (as recited in the claims, but not excluding external communication with a central computer for security/informational purposes). The McCauley system, even though using a term ("universal game interface 32" (column 5, lines 61-65) that sounds similar to the universal control board used in the present invention, describes both an element and a system completely distinct from that recited in the claims.

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

The claims recite a single gaming apparatus having all of the required hardware and software recited in the claims present in the single device. The Universal control board is within the apparatus to enable game rules to be replaced, without requiring peripheral controls to be replaced. The Universal control board contains the ability to interface and communicate with the peripherals, even with a change in game play rules. The system of McCauley does no more than provide a 'splitter' allowing access to a single processor (4) and set of software (20) from multiple player control input systems 40 42 44 46. The universal game interface 32 of McCauley does no more than allow different players to access the host computer 4 at a distal location at the same time. This play system would be effective for arcade games played in a multi-game arcade game array or over the internet. Even though the McCauley arcade game system may contain many of the components used to build the casino gaming system of the present invention, the pieces are used in a distinctly different manner and that different manner is recited in the claims, even claim 1, reciting

“...a) computerized wagering game status information and

b) symbol elements that change with the play of the wagering game;

a communication port communicatively coupled to the computerized game controller;

an interface assembly comprising one or more user interface devices; and

an I/O interface adapter configured to communicatively couple the interface assembly to the communication port and convert at least some signals between the interface formats supported by the interface assembly and the universal controller; and

the communication port connected to gaming peripherals that can be communicated with by the computerized gaming controller.”

The exterior PC communication system of McCauley for an arcade has no fundamental relationship to the wagering game system of claim 1, where all components are recited as within the system.

The addition of Kelly provides no functional motivation to specifically modify the underlying multi-user interface system of McCauley with the "Prize Redemption System" of Kelly. Even though there are a few statements that vaguely suggest a casino-type usage of the Kelly system, the invention is directed towards a Prize Redemption System, where indicators of

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

prize credit are provided at the machine and redeemed elsewhere. The disclosure used in the present rejection is merely that some of the parts (hardware and software) that was not used by the multi-player network system of McCauley can be found within the disclosure of Kelly. It is then asserted that the various pieces found in Kelly can be used in the system of McCauley. This rejection is not well founded in law or fact.

This type of piecemeal selection of components from references without a sensible motivation for selecting those specific components is a type of rejection that has long been refuted by the courts.

“Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has provided no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known...To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed combination to be obvious in light of the teachings of the references. We find nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the examiner. Additionally, as aforementioned, we find no line of reasoning in the answer, and we know of none, as to why the artisan would have found the modifications urged by the examiner to have been obvious. (Ex parte Clapp, 227 U.S.P.Q 972 (1985 US PTO Bd of Appeals and Patent Interferences) (emphasis added)

Although the rejection has detailed the nature of the elements disclosed in each of the references, and cited the portion of those references where the disclosures are to be found in a most thorough manner, this only means that the individual elements have been clearly shown, not that there is motivation or better motivation to select those particular elements.

Similar holdings by the C.A.F.C. strongly assert that this requirement is essential to a finding of obviousness. As stated in ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 U.S.P.Q. 933 (Fed. Cir. 1984):

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH
UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings may be combined only if there is some suggestion or incentive to do so.”

This motivational teaching is clearly absent from the combination of references. It must also be made clear that motivation would not be provided by asserting that it would be desirable to have each of the additional elements absent from McCauley but shown by Kelly to perform the functions shown by Kelly. That would be clear hindsight reconstruction of the invention. This would be particularly egregious as the intent and field of the disclosures of McCauley and Kelly are so dissimilar. McCauley is directed as networking or providing multiplayer platforms for arcade games. The combination of references is attempting to convert the multiplayer format of McCauley into a novel universal computer-based housing system for gaming operations with particular hardware and software recited in the claims to support that function. Kelly does not provide that motivation. Kelly merely provides a showing that certain components not shown by McCauley are known in the art. These components are incidentally shown by Kelly in the disclosure of his prize redemption system. There is no motivation for combining the components, combining the technologies of the two references, altering the technical direction of the two references, and providing a gaming system that resembles neither of the devices disclosed by the references.

Additionally, there is substantial information recited in the claims that also clearly differentiates the invention and the field of the invention from the prior art. Among such limitations are (from claim 1):

- a) computerized wagering game status information and
- b) symbol elements that change with the play of the wagering game.

There is absolutely no disclosure in either of the references used in the rejection with regard to these types of limitations in the claims. The rejection is fatally deficient with respect to providing disclosure of underlying limitations and elements of the claimed invention.

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

The rejection fails to appreciate the underlying concept of the invention recited in the claims. This failure will be analyzed with respect to claim 1, with that claim reproduced below, and salient deficiencies in the prior art used in the rejection highlighted in the claim.

A computerized wagering game apparatus, comprising:
a computerized game controller operable to control a computerized wagering game;
a video display device providing a visual representation of a signal provided by the computerized game controller such that the video display and/or slot display device displays at least one visual image selected from the group consisting of
a) computerized wagering game status information and
b) symbol elements that change with the play of the wagering game;
a communication port communicatively coupled to the computerized game controller;
an interface assembly comprising one or more user interface devices; and
an I/O interface adapter configured to communicatively couple the interface assembly to the communication port and convert at least some signals between the interface formats supported by the interface assembly and the universal controller; and
the communication port connected to gaming peripherals that can be communicated with by the computerized gaming controller.

Each of these features in wagering apparatus is absent from the disclosure of the references cited in the rejection. Additionally, the concept of executing peripheral controls in the universal controller from a single computer (e.g., the main processor) has not been disclosed in the art cited in the rejection. McCauley teaches that peripheral controls are executed by a dumb processor that is separate from the main processor. (column 2, lines 47-50)

The subject matter of claims 1-8, 11-28 and 31-33 clearly is not obvious under the Court instructed guidelines of 35 U.S.C. 103(a) in view of McCauley and Kelly.

The Rejection of Claims 9-11, 13-16 and 29 under 35 USC 103(a) as unpatentable over *Arcade Machine Retrofit* (October 1996) in view of Kelly.

This rejection fails for all of the reasons indicated above with respect to the rejection of claims over McCauley in view of Kelly and additional reasons. The retrofit suggested by Arcade is with respect to an arcade game, clearly emphasized in the text and title. More importantly, the article literally begins with the description of the process of retrofitting as ripping everything out from the arcade box. This is a substantially different procedure as compared to the practice of

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

the present invention where substantive hardware, software and mechanical components are left in the machine, and the removed hardware/software is replaced with a universal system that is capable of supporting not only the games immediately installed, but also games later installed by simply replacing game rules and game specific information, without necessarily needing to rip everything from the box again and installing a complete system a second time.

Again, the distinction between the arcade game field of technology (practiced by Arcade, and primarily but not exclusively practiced by Kelly) and the gaming apparatus technology is quite substantive. The present process uniquely addresses issues that are present in gaming apparatus that are insignificant or absent in arcade games, such as the effects of modification on gaming regulations, gaming commission approval, and gaming security. By using the universal board containing peripheral controls (which specifically is recited in the claims), subsequent replacement will be effected by replacement of as little as a single gaming element (a chip) specific to the rules of a game. All other information, hardware, software, peripheral controls, etc. is already present in the universal board and/or residing in the game engine software, and the new game can be installed with a single chip. This has never been accomplished, suggested or taught publicly prior to the present invention.

The differences between arcade games and gaming apparatus are relevant to the actual field of the invention. The present invention as claimed and as originally claimed recites computerized wagering game apparatus, while the reference art used in the rejection is uniformly directed towards arcade games. Contrary to the assertion in the rejection to the contrary, the retrofit in Arcade is technology from non-analogous art and does not form a good basis for even beginning an analysis of the present invention. This is evident not only by the presence of higher security requirements that is acknowledged in the rejection, but also by the inclusion of different functionalities provided in the respective play of gaming devices. Among the various features that clearly distinguish commercial gaming systems versus commercial arcade games are at least the following:

- 1) arcade games almost always embody skill functions. Although some literature on gaming systems reference skill and skill functions, no US jurisdictions allow genuine skill capability in the play of wagering systems. Any skill ability is, for example, in maintaining specific cards in the play of differing strategies (as in draw poker), not in

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

any special physical ability or selection of alternatives that clearly, predictably and directly affect results (e.g., choosing a correct answer in a trivia game, or shooting a target).

- 2) Information regarding game play and credit and game status is not supported and maintained as a critical element in power shutdowns in game systems, while it is an important element in gaming systems.
- 3) The dismissal of security as a trivial element or difference between gaming systems and games does not acknowledge sufficient importance or complexity to such security efforts. The security must protect against a vast array of potential adversarial interventions, including both physical (mechanical and electrical and electromagnetic) and electronic (data software manipulation). This is far from the trivial consideration given these distinctions in asserting equivalence in the rejection.

It is therefore a fundamental element in the traversal of the rejection that game technology and the gaming technology are not equivalent. Even though specific formats of wagering within the gaming industry may be referred to as 'games,' wagering 'games' in the gaming industry represent a distinct field of commerce. Even within the search areas in the US Patent and Trademark Office, distinct subclasses are provided for wagering versus standard game play, skill elements are segregated into distinct search areas. Any asserted equivalence does not exist.

In addition to the structural difference and functional differences described as differentiating the wagering gaming industry from video arcade games, the markets operate differently. These market operating differences provide enhanced utility for the practice of the present invention that would not be met by a similar practice in the arcade game industry.

For example, the gaming industry utilizes a recurring licensing revenue model. This makes the inventive concept of a limited retrofit recited in the process claims and enabled by the structure recited in the apparatus claims much more appealing. The partial retrofit described in the present invention reduces the hardware/apparatus cost in providing a 'new' or retrofit game. Additionally, there are even greater potential savings by the potential elimination of licensing fees on the games. Additionally, there are laws in some gaming jurisdictions that require that cabinets be maintained (as a security and fraud evidence matter). Older gaming apparatus must therefore be warehoused, which is an accumulating expense. The partial retrofit enabled in the

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

practice of the present invention allows upgrading and partial replacement of significant components, at a minimum cost, yet providing the latest technology and a wide variety of games in the old cabinets. This has not heretofore been enabled except by the complete removal and complete replacement of each and every computer driven function in the machine – the same type of rip out everything practice identified by Arcade. The partial retrofit described in the claims and enabled in the apparatus claimed is therefore a unique opportunity and uniquely suitable to the gaming industry.

Additionally, the teachings in Arcade teach nothing reasonable to the practice of the present invention. A brief review of Arcade shows that it is nearly a worthless reference with regard to the recited practice of the invention.

The first step taught by Arcade is “Rip out everything from the box!” (emphasis natural). The second step in Arcade is “Rewire the buttons.” The third step is “Chop up a keyboard.” The entire procedure and disclosure is to replace one existing play system with another complete play system. There is no concept of providing a universal peripheral wagering game system that can then be driven by replaceable wagering game rules provided as a distinct component. One additional significant advantage references above is the fact that the designs and methods recited in the claims enable the universal controller to adapt to different peripherals instead of rewiring and reconfiguring the entire apparatus, cabinet and box. The process performed by Arcade is precisely the type of complete stripping and reconstruction that is avoided in the practice of the present invention. This is clearly brought out in the process claims and enabled in the structure of the apparatus and devices claimed.

This disclosure teaches away from the very underlying concepts of the present invention, which is to conserve as much of the original box and components as possible, without having to rebuild the system after ripping everything out. From the very direction that Arcade takes, it immediately leads away from the practice of the present invention from a field of use (video arcade games versus gaming) that is different from the practice of the presently claimed invention.

Note the distinct difference of this process (the only retrofitting process cited in the art used in the rejection) and the process recited in claim 9:

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

“...a) removing an original special-purpose computerized game controller used to control a computerized wagering game from the apparatus, the original computerized game controller designed to and capable of working exclusively with a particular computerized wagering game apparatus;

b) inserting a universal computerized game controller operable to control a video wagering game that can be played on the video wagering game apparatus and at least some interface devices on the apparatus, the peripherals having been connected to the original computerized game controller through a wiring harness that is not removed when the original special-purpose computerized game controller is removed;

b) inserting a universal computerized game controller operable to control a video wagering game and/or slot wagering game that can be played on the video and/or slot wagering game apparatus and an I/O interface that operatively couples the universal computerized game controller to user interface devices of the wagering game apparatus, the I/O interface adapter configured to communicatively couple the interface assembly to the communication port and a) convert at least some signals between the interface formats supported by the interface assembly and the universal controller and/or b) the I/O interface having digital logic to perform at least one function selected from the group consisting of buffering and latching signals;...”

These functions, and especially the functions in **bold** text, are completely absent from the teachings of the references in this rejection. As the limitations are completely absent from the references, the rejection must fail as a matter of law.

Rather than ripping out the entire box (the quote from Arcade), the game controller is removed, and the wagering game elements remain in the system unchanged and are then driven by the inserted universal game device. These steps are not shown by Arcade in view of Kelly. **THERE IS ABSOLUTELY NOTHING IN EITHER REFERENCE ABOUT THE INSERTION OF A UNIVERSAL COMPUTERIZED GAME CONTROLLER HAVING THE RECITED FUNCTION, ESPECIALLY IN THE I/O INTERFACE.** The absence of this limitation is emphasized in claims 27-37 where the I/O interface is required to have digital logic that performs functions on the signal. This is totally distinct from any disclosure

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

in either reference. On the basis of just this single limitation, the rejection of all method claims is clearly in error.

The distinctions in the limitations of claim 19, reproduced below, are even more distinguishing and unobvious from the disclosure and teachings of McCauley in view of Arcade:

"A method for reconfiguring a computerized wagering game apparatus having a harness for associating computerized game controller with output devices in the apparatus, the method comprising:

a) removing an original special-purpose computerized game controller used to control a computerized wagering game from the apparatus, the original computerized game controller designed to and capable of working exclusively with a particular computerized wagering game apparatus;

b) inserting a universal computerized game controller operable to control a video wagering game that can be played on the video wagering game apparatus and an I/O interface that operatively couples the universal computerized game controller to user interface devices of the wagering game apparatus; and

c) sending signals from the computerized game controller through the I/O and harness to communicate between the computerized game controller and the user interface devices.

Kelly deals with the construction of a prize redemption system in a game, and Arcade deals with the wholesale stripping of all material from a game and its replacement with an entirely new system. There is no concept in one or the other or the combination of references for removing a special wagering game specific computer from a wagering game apparatus, leaving other elements within the apparatus, and providing a new wagering game controller of the type recited in the claims. This process is even further limited an elucidated in claims 19 and 30,

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

where at least one specific feature is required to be left in the original apparatus, as are the other required process steps that distinguish from Kelly in view of Arcade.

Claim 10 similarly requires that the "...display device displays at least one visual image selected from the group consisting of a) computerized wagering game status information and b) symbol elements that change with the play of the wagering game." This is not shown by either reference or the combination of references.

Claim 18 requires a combination of specific elements that are not suggested by the combination of Kelly in view of Arcade. Specifically claim 18 recites:

18. An interface adapter configured to operatively couple an interface assembly to a communication port operatively coupled to a computerized video and/or slot wagering game controller comprising nonvolatile storage with instructions stored thereon, the instructions when executed operable to cause the computer to execute a video and/or slot wagering game controlled via the user interface assembly.

The highlighted limitations are clear recitations of elements and their function in the practice of the invention. This combination of elements and their functions are not shown in the combination of McCauley in view of Arcade, which has been used to reject the claims. In particular, there is no interface adapter operatively coupling an interface assembly to a communication port coupled to a computerized video wagering game controller comprising volatile storage with instructions stored therein. These highlighted features and functions are clearly absent from the combination of references used in the rejection. Claims 22-25 further recite an aspect of the invention emphasizing these points and also clearly distinguish from the two references cited in the rejection.

The Rejection of Claim 12 under 35 USC 103(a) as Unpatentable over Arcade in View of Kelly (as applied to claims 9-11, 13-16 and 29) When Further Considered with McCauley.

This rejection must fail for all of the reasons given above with respect to both rejections discussed above. The combination of references has been shown to leave at least some of the

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Docket No.: PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

same holes in both combinations. Combining more references that posses the same wholes, and provide no motivation to practice the technology of the claimed invention does not establish obviousness for the narrower claims. Even though McCauley does show the use of a USB port, that single disclosure does not overcome the deficiencies noted in the combination of Kelly in view of Arcade with respect to the limitations of claim 10, from which claim 12 depends.

RESPONSE TO THE COMMENTS OF THE EXAMINER

The essence of the comments provided by the Examiner in the Office Action mailed on April 20, 2001 is to the effect that "It is common necessity to upgrade obsolete processors for faster, more capable system" and this is, in effect, all that the presence invention claims. It is this preconception of what is being performed in the present invention that forms the erroneous basis for the rejection.

The present invention is not merely an upgrade in processor capability. It is a complete reconfiguring of the architecture to enable ready design and implementation of games on the supporting new architecture. There is no other system available, in arcade games or video wagering games that provides underlying intelligence that can be used in the design and play of multiple games. In video arcade games, each game has its complete software system. Different games are played by complete replacement of the game card and game chips. There is no immortal component with intelligence that can be used in multiple games. There are no fundamental game properties (e.g., image graphics) that can be carried from game to game, without the need to design new imagery for each new game.

By practice of the present invention, imagery of cards is maintained in the apparatus and the imagery is executed by the game controller. This is recited within the claim language (e.g., claim 18) of:

"...a computerized video wagering game controller comprising nonvolatile storage with instructions stored thereon, the instructions when executed operable to cause the computer to execute a video and/or slot wagering game controlled via the user interface assembly.

This is a system that is fundamentally antagonistic to the underlying design of video arcade games and personal arcade games.

PRELIMINARY AMENDMENT

Applicant: Mark L. Yoseloff.

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

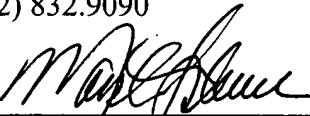
CONCLUSION

All rejections have been shown to be in error. All rejections should be withdrawn and all claims allowed.

Respectfully submitted,

Mark L. Yoseloff
By his Representatives,
MARK A. LITMAN & ASSOCIATES, P.A.
YORK BUSINESS CENTER, SUITE 205
3209 West 76th Street
Edina, MN 55435
(952) 832.9090

Date DECEMBER 13, 2002

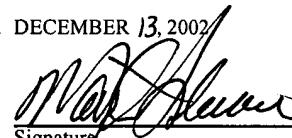
By 

Mark A. Litman

Reg. No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on DECEMBER 13, 2002

Name Mark A. Litman


Signature